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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,747	08/28/2001	Shelby Freland Thames	TH1802 (US)	5763

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09/25/2002

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EXAMINER

SHORT, PATRICIA A

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940747

Applicant(s)

Thames et al

Examiner

Shont

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on January 2, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☒ The proposed drawing correction, filed on 12/31/01 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2/6
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1712

The amendment filed January 2, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Support for the change in Table 8 from PT-30 to PT-15 is not apparent. Applicant relies upon Figure 4 to support this change. However, it appears that Figure 4 is derived from the data in columns labeled T-00, T-30, T-30 and T-50 in Table 8. Figure 4 appears to support a change from T-30 to T-15 for the second column in Table 8 rather than a change from PT-30 to PT-15 in the last two columns.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are confusing in that claim 1 requires an aliphatic glycol that is 5 to 90% 1, 3-propane diol while claim 2 recites a Markush group of aliphatic glycols in which 1,3-propane diol is not even a member and claim 3 requires neopentyl glycol. In claims 5 and 14, it is not clear what is meant by neopentyl glycol substituted with 15 to 50% on a molar basis with 1,3-propane diol. Does the polyester contain 15 to 50% on a molar basis of 1, 3-propanediol with the remainder of the aliphatic glycol being neopentyl glycol? Claim 11 does not appear to further limit claim 1 that requires an aliphatic glycol that is 5 to 90% 1, 3-propane diol. In claims 6 and 7, "and" rather than "or" should be used to join members of the Markush groups.

Art Unit: 1712

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merck. The reference teaches powder coating compositions comprising a polyester made from terephthalic acid and neopentyl glycol with another aliphatic diol, and glycidyl isocyanurate having improved mechanical properties. See examples. Neopentyl glycol is used in amounts of at least 50% with other aliphatic diols that include 1, 3-propanediol and optional branching agents. See column 3, lines 34-50. As suggested by the reference, it would have been obvious to use a combination of at least 50% neopentyl glycol with 1, 3 propanediol when preparing the polyester and combine with glycidyl isocyanurate in order to obtain a powder coating having improved mechanical properties. Absent a showing of criticality commensurate in scope with the claims, the claims are unpatentable over the reference.

Claims 1-3 and 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsiat. The reference teaches powder coating compositions comprising a polyester made from terephthalic acid and isophthalic acid with neopentyl glycol and another aliphatic glycol, and glycidyl isocyanurate having improved properties. See Example 6. Other aliphatic glycols include 1, 3-propanediol. See column 3, lines 53-56. As suggested by the reference, it would have been obvious to use a combination of neopentyl glycol and 1, 3 propanediol with a combination of terephthalic acid and isophthalic acid when preparing the polyester and combine with glycidyl isocyanurate in order to obtain a powder coating having improved properties. Absent a showing of criticality commensurate in scope with the claims, the claims are unpatentable over the reference.

Application/Control Number: 09/940,747

Page 4

Art Unit: 1712

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September 18, 2002

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